

REMARKS

Claims 1-15 and 18-35 are pending, with all pending claims being currently amended and previously withdrawn claims 16, 17, 36, and 37 being cancelled without prejudice. Applicants' reserve the right to pursue the subject matter of the withdrawn claims in a divisional application.

Independent claim 1 has been amended to recite that the anisotropic light diffusion adhesive layer comprises, in part, the acicular filler being dispersed as oriented substantially in the same direction in the adhesive material, and that a glass transition point of the adhesive material is within a range of -60°C to -15°C, while a mass average molecular weight of the adhesive material is within a range of 100,000 to 2,000,000.

Independent claim 18 has been amended to recite that the anisotropic light diffusion adhesive laminated assembly comprises, in part, two or more adhesive layers which comprise an adhesive material and are adjacent with each other. In addition, claim 18, like claim 1, similarly recites that the acicular filler is dispersed as oriented substantially in the same direction in the adhesive material, and that a glass transition point of the adhesive material is within a range of -60°C to -15°C, while a mass average molecular weight of the adhesive material is within a range of 100,000 to 2,000,000.

Support for the amendments to claims 1 and 18 can be found throughout the specification and, more specifically, at least on page 11, lines 9-18, for example.

The remaining dependent claims 2-15 and 19-35 have been amended to more clearly define the invention by replacing, where indicated, the indefinite article "a" or "an" with the definite article "the".

In the Official Action, claims 1-15 and 18-35 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. More particularly, the Examiner states that in claim 18, line 2, it appears proper to state that the two or more adhesives are "adjacent"; and in each of independent claims 1 and 18, it also appears proper to insert just before the period the phrase "in the adhesive material" so as to clearly indicate that the filler materials are indeed located in the adhesive material. *See* Page 2 of the Official Action. In view thereof, independent claims 1 and

18 have been amended specifically in accordance with the Examiner's suggestions. To that end, Applicants submit that the rejection of claims 1-15 and 18-35 under 35 U.S.C. §112, second paragraph, as being indefinite, is overcome and, thus, must be withdrawn.

Also in the Official Action, claims 1 and 5 stand rejected as being anticipated by JP Publication 2001-249205 machine translation ("JP '205").

In rejecting independent claim 1 (and dependent claim 5) over JP '205, the Examiner states that it "discloses an anisotropic diffusion layer 3 having a plurality of fibrous (i.e. acicular) light diffusing agents 6 (i.e. fillers) dispersed substantially parallel to one another in a binder 5 (i.e. adhesive). As such, the refractive index of the fibrous agent is clearly different from the binder, thus meeting the limitations of claim 1..." See Page 3 of the Official Action. Applicants submit that the rejection is in error and should be withdrawn, particularly in view of amended independent claim 1.

The Examiner can appreciate that "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). For the following reasons, JP '205 clearly fails to teach each and every element of Applicants' anisotropic light diffusion adhesive layer, as recited in independent claim 1.

Applicants' independent claim 1 now calls for the adhesive material to have a glass transition point within a range of -60°C to -15°C and a mass average molecular weight within a range of 100,000 to 2,000,000.

With respect to JP '205, this reference simply fails to disclose that its adhesive layer 5 has a glass transition point within a range of -60°C to -15°C and a mass average molecular weight within a range of 100,000 to 2,000,000, as required by independent claim 1. Thus, Applicants submit that JP '205 does not teach Applicants' anisotropic light diffusion adhesive layer. Therefore, the rejection of independent claim 1 (and dependent claim 5) over JP '205 cannot stand and must be withdrawn.

Also in the Official Action, claims 1-15 and 18-35 stand rejected as being

unpatentable over either Yano U.S. Patent Application Publication No. 2000/0002153 ("Yano") or JP Publication 11-223712 ("JP '712") in view of either JP Publication 08-327805 ("JP '805") or JP '205.

In rejecting independent claims 1 and 18, the Examiner states that the primary references, i.e., Yano and JP '712, disclose light diffusion adhesive sheets which can be laminated to a wide variety of optical materials, yet, lack "a teaching of the presence of acicular fillers that are aligned in a desired direction so as to produce anisotropic light patterns, and in the case of Yano it is also not taught that the refractive indexes of the filler and the adhesive matrix must be different." In an effort to fill that teaching void, the Examiner looks to the secondary references of JP '805 and JP '205. In doing so, the Examiner states that "one of ordinary skill who is desirous of obtaining such optical articles would have more than ample motivation to incorporate the aligned fillers of the secondary references into each of the primary references in place of their non-acicular fillers, and thereby form, or clearly render obvious, the claimed genus of optical articles". And, with respect to claim 18, which requires the presence of at least two adhesive layers, the Examiner states that it is "believed to be a modification well within the ordinary skill of the art". See Pages 3 and 4 of the Official Action. Applicants respectfully disagree and submit the rejection is in error and should be withdrawn.

The Examiner can appreciate that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). There is clearly no such teaching in the cited references. In fact, Applicants submit that the Examiner is merely substituting for the lack of prior art teachings in the primary references (Yano and JP '712) the notion that a skilled artisan would experiment with and select fillers with acicular characteristics that are optimized for use in light diffusion adhesive layer. See Page 4 of the Official Action. Such a notion turns the rejection into one that is based on an "obvious to try" test. That is not the law. *In re Deuel*, 34 USPQ2d 1210, 1216 (Fed. Cir. 1995) (stating that "Obvious to try" has long been held not to constitute obviousness).

As already acknowledged by the Examiner, both Yano and JP '712 not only fail to

disclose acicular fillers, but acicular fillers that are oriented substantially in the same direction in the adhesive material, as required by independent claims 1 and 18. Clearly, both Yano and JP '712 specifically disclose non-acicular fillers. In view thereof, what motivation can there be to completely replace those non-acicular fillers, where no acicular fillers are taught or suggested, with the acicular fillers of the secondary references? There is none. Rather, this wholesale filler substitution is nothing more than the oft overused and improper obvious to try rationale. And, even if one were to replace the non-acicular fillers of the primary references with the acicular fillers of the secondary references, where exactly is the additional motivation to orient those fillers substantially in the same direction in the adhesive material, as required by claims 1 and 18? It simply does not exist. Accordingly, Applicants submit that the rejection of claims 1 and 18, and their dependent claims, is improper and must be withdrawn.

Furthermore, even assuming *arguendo* that one skilled in the art would specifically combine Yano with JP '805 or JP '205 (which we submit one would not), the combination of the references still fails to teach or suggest Applicant's invention as recited in claims 1 and 18. To establish *prima facie* obviousness of a claimed invention, it is certainly well established that all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

As indicated above, independent claims 1 and 18 specifically call for the adhesive material to have a glass transition point within a range of -60°C to -15°C and a mass average molecular weight within a range of 100,000 to 2,000,000.

Briefly, by way of background, by employing the adhesive material having those characteristics, the presently claimed invention enables reliably solving the following problem, which is discussed on page 12, lines 11-17 of Applicants' specification: "With a 180° peeling off strength which is below 100 g/25 mm, the environmental resistance becomes insufficient, and, in particular, there is a fear that detachment will occur during high temperature and/or high humidity; while, on the other hand, with one which exceeds 2000 g/25 mm, it is difficult to rectify errors in the adhesion, and, even if it has been possible to rectify such an error, the situation is not desirable, because there is a danger that some adhesive material will remain upon

the portion which has been peeled away.” That is, the present invention according to the currently amended claims 1 and 18 clearly defines the specific feature for realizing the appropriate peeling off strength (i.e., an appropriate adhesiveness) that is neither too strong nor too weak.

To that end, upon review of Yano, JP '805, and JP '205, each reference simply fails to disclose that its adhesive layer has a glass transition point within a range of -60°C to -15°C and a mass average molecular weight within a range of 100,000 to 2,000,000, as required by independent claims 1 and 18. Thus, Applicants submit that, even if combined, the combination of Yano and JP '805 or Yano and JP '205 fails not only to provide the above-mentioned advantageous effect but still further fails to teach or suggest Applicants' anisotropic light diffusion adhesive layer. In view thereof, the obviousness rejections of independent claims 1 and 18, and their dependent claims, over Yano in view of either JP '805 or JP '205 cannot stand and must be withdrawn.

No Prima Facie Case

For all of the above reasons, it is submitted that the claims as pending are patentable over the cited references, and that no prima facie case of obviousness was made before, nor would be applicable here over that same art. In that regard, the additional art cited by the Examiner as being of interest is submitted not to change the situation.

Conclusion

As a result of the remarks given herein, Applicants submit that the rejections of the pending claims have been overcome. Therefore, Applicants respectfully submit that this case is in condition for allowance and request allowance of the pending claims.

If the Examiner believes any detailed language of the claims requires further discussion, he is respectfully asked to telephone the undersigned attorney so that the matter may be promptly resolved. Applicants also have submitted all fees believed to be necessary herewith.

Should any additional fees or surcharges be deemed necessary, the Examiner has authorization to charge fees or credit any overpayment to Deposit Account No. 23-3000.

Respectfully submitted,
WOOD, HERRON & EVANS, L.L.P.
By /Randall S. Jackson, Jr./
Randall S. Jackson, Jr.
Reg. 48,248

2700 Carew Tower
Cincinnati, OH 45202
(513) 241-2324
(513) 241-6234 (facsimile)